

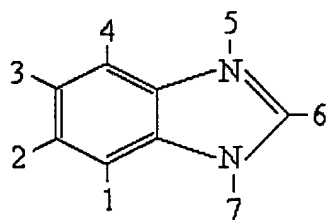
Remarks

In the Office Action of May 14, 2004, the Examiner affirmed the restriction requirement set forth in the previous office action and rejected the claims under 35 U.S.C. § 112 and 35 U.S.C. § 103 over U.S. Patent No. 5,331,003 to O'Doherty ("O'Doherty"), U.S. Patent No. 6,034,116 to Assmann et al. ("Assmann") and U.S. Patent No. 3,271,249 to Clegg et al. ("Clegg").

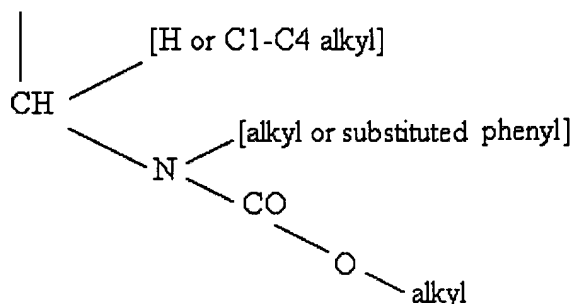
The rejection under 35 U.S.C. § 112 and the objections to the specification have been addressed in the foregoing amendments. Applicant has requested a certified copy of the German counterpart to this application and will file it upon receipt.

The rejection under 35 U.S.C. § 103 is respectfully traversed. In the Office Action of May 14, 2004, the Examiner argued that O'Doherty, and Assmann show benzimidazolines in combination with polyether antibiotics, while Clegg shows halogenated substituents. Applicant contends that the claimed structures are not found in the cited references, and their structure is not obvious in view of the cited art. Since the structures are not obvious, the combination of those unobvious structures with known compounds would not have been obvious.

Benzimidazoles have a structure with several possible places to attach various ligands. For purposes of this amendment only, the following identification of these sites will be adopted:



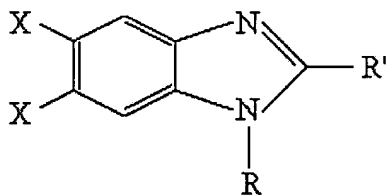
The claimed invention, for example, has a closed -O-CF₂-CF₂-O- ring at positions 1 and 2, chlorine or bromine at position 4, fluoroalkyl at position 6, and, at position 7, a specifically claimed ligand:



The Examiner has conceded that O'Doherty does not disclose the claimed benzimidazole. Specifically, O'Doherty does not have either the fused ring at positions 1 and 2 of the benzimidazole nor the ligand at position 7. O'Doherty does have a ligand at position 7, R⁴, that may be H, OH, OCH₃ or a group hydrolyzable to one of those groups, but that ligand cannot teach or suggest the claimed ligand. Indeed the current application cites O'Doherty at page 1, lines 20-21, but concludes that the effectiveness of the O'Doherty compounds is "not satisfactory."

In the Office Action, the Examiner asserted that Assmann shows the claimed benzimidazolines. But, Assmann does *not* describe the claimed compounds, despite the assertions of the Examiner. While Assmann does disclose the fused dioxyalkylene ring of the claimed compounds, the fused ring is *not* at positions 1 and 2 (R_3 and R_4 in Assmann's diagram (I)). As shown by examples 73-89, 146-161, 165-167 of Assmann, the fused ring, when found at all, is found at positions 2 and 3 (R_2 and R_3 in Assmann), and *not* at positions 1 and 2.

Clegg discloses a dihalobenzimidazole having the following structure:



This structure does not teach or suggest the claimed invention. The fused ring at positions 1 and 2 is missing, and the R group does not begin to describe the ligand at position 7 of the claimed invention. Thus, there is no teaching or suggestion to use the benzimidazole of the claimed invention for any purpose whatsoever.

Since there is no teaching or suggestion that the claimed compounds may be used in combination with the other claimed actives in the cited art, the rejections should be withdrawn.

Applicant also points to the allowed parent patent and to the restriction requirement in this application. Applicant suggests that the parent patent, U.S. Patent No. 6,620,833, shows that the claimed compounds are patentable in and of themselves. Combinations of these patentable compounds with other active ingredients should also be patentable.

The Examiner maintained the restriction requirement because certain ligands “could constitute patentably distinct inventions.” If so, then the distinct ligands in this application should also patentably distinguish the claims from the cited art.

For the foregoing reasons, withdrawal of the rejections and allowance of the pending claims is respectfully solicited.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read "Richard S. Bullitt", with a stylized flourish at the end.

Richard S. Bullitt
Reg. No. 30,733

Bayer HealthCare, LLC
36 Columbia Road
Morristown, NJ 07962